

### **DISCUSSION SUMMARY**

Applicant wishes to express appreciation to Examiner Park for the telephone discussions of August 18, 2005. During the discussion, Applicant's Representative, Attorney William Boshnick, spoke to the Examiner concerning the rejected claims of the present invention. Specifically, with respect to rejected independent claims 20, 24, 30 and 33, Applicant's Representative read a proposed clarifying amendment to independent claim 20 (to which independent method claim 30 generally corresponds) and to independent claim 24 (to which independent method claim 33 generally corresponds), to clarify the independence of the management center from the recipient.

Specifically, with respect to independent claim 20, Applicant's proposed amendment included, *inter alia*, the limitation that ---the email address of the management center being independent of the recipient to which the image data is transmitted by the facsimile transmitter based on the facsimile protocol---. With respect to independent claim 24, Applicant's proposed amendment included, *inter alia*, the limitation that ---the management center being independent of the recipient to which the image data is transmitted by the facsimile transmitter based on the facsimile protocol.---

Applicant's Representative noted that, to the contrary, the apparatus of the applied OTSUKA reference transmits an e-mail (containing image data) to the addressee stored in the EEPROM 14, and transmits the image data to *the same addressee* stored in this EEPROM 14. Applicant's Representative noted that therefore, as shown in Fig. 7, these two transmissions are performed

dependently and not independently, given the correspondence relationship between the email address and facsimile number of the user.

Later that day, after further considering the OTSUKA reference in view of the proposed claim amendments, the Examiner called back Applicant's Representative and noted that such an amendment would appear to overcome OTSUKA, but indicated that a further search may be required, before agreeing to allow the present application.

Applicant greatly appreciates the Examiner's consideration in this regard, and notes that the present amendments to claims 20, 24, 30 and 33 are substantially the same as those discussed with the Examiner.

**REMARKS/ARGUMENTS**

Upon entry of the present amendment, claims 17-18 and 28-29 will have been canceled without prejudice or disclaimer, and claims 20-22, 24 and 30-33 will have been amended for consideration by the Examiner, with claims 19,23, and 27 standing allowed. In view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Turning to the merits of the action, the Examiner has objected to Claim 17 because of informalities. Namely, the Examiner has requested that in line 10, "management center" should be ---predetermined management center---. By the present amendment, Applicant has canceled claim 17 without prejudice or disclaimer. Thus, Applicant respectfully submits that the objection has been rendered moot.

The Examiner has objected to claim 24 under 37 C.F.R. § 1.75 (a). Without agreeing to the propriety of the Examiner's objection, since Applicant submits that one skilled in the art would readily understand how the conversion can be done to the data that is already transmitted in this claim, by the present amendment, Applicant has amended claim 24 to further clarify how the conversion can be done to the same data as the data already transmitted. Thus, Applicant respectfully requests that the Examiner withdraw the objection.

The Examiner has rejected claims 17 and 28 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, as well as, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. By the present amendment and without agreeing to the propriety of this rejection, Applicant has canceled claims 17 and 28 without prejudice or disclaimer. Thus, Applicant respectfully requests that the Examiner withdraw this rejection.

The Examiner has rejected claims 20 and 30 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. While Applicant's disagree with the Examiner's rejection, since one skilled in the art would readily understand the meaning of "independently transmit[ing] the e-mail to each of the destination", by the present amendment, Applicant has amended claims 20 and 30 to further clarify the independent relationship between the management center and the recipient, without agreeing to the propriety of this rejection and solely to expedite the patent application process. Thus, Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner has rejected claims 17, 18, 28 and 29 under 35 U.S.C. § 102(e) as being anticipated by YOSHIDA et al. (U.S. Patent No. 6,801,546). By the present amendment, Applicant has canceled claims 17, 18, 28, and 29 without prejudice or disclaimer. Thus, Applicant respectfully submits that the rejection has been rendered moot.

The Examiner has rejected claims 20, 21, 24, 25, 30, 31, 33 and 34 under 35 U.S.C. § 102(e) as being anticipated by OTSUKA et al. (U.S. Patent No. 6,700,674). The Examiner also has rejected claims 22, 26, 32, and 35 under 35 U.S.C. § 103 (a), as being unpatentable over OTSUKA et al. in view of WOLF (U.S. Patent No. 6,535, 303). Applicant respectfully traverses both grounds of the rejections.

As noted above, Applicant has canceled claims 17-18 and 28-29 without prejudice or disclaimer, and has amended (by clarifying the limitations therein) 20, 24, 30, and 33 for consideration by the Examiner. In view of the herein-contained remarks, Applicant respectfully traverses the above rejection, based on the pending claims 19-27 and 30-36, and will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter, but do not narrow the scope of the claims.

In non-limiting embodiment, Applicant's independent claim 20 generally relates to an image communication apparatus which has a scanner configured to scan image data and a panel configured to input an address of a recipient. The image communication apparatus of claim 20 has a memory which stores an e-mail address of a management center. The image communication apparatus of claim 20 also has a controller which converts the scanned image data into data for Internet transmission, attaches the converted data to an e-mail, and transmits the e-mail to both of the address of the recipient input by the panel and the e-mail address of the management center. Further, the e-mail is independently

transmitted to the address of the recipient (*i.e.*, without passing through the management center). The management center of claim 20 further manages information that the image communication apparatus transmits to the address of the recipient input by the panel and further is configured to connect to the image communication apparatus via the Internet. The management center of claim 20 is distinct from the recipient of the address input by the panel, the e-mail address of the management center is independent of the recipient of the address input by the panel, and the e-mail is transmitted to the management center based on the e-mail address stored in the memory. Applicant notes that the present specification supports an embodiment in which the memory stores the e-mail address of the management center, for example, at page 8, lines 22-23. Claim 30 generally recites a related method.

In non-limiting embodiment, Applicant's independent claim 24 generally relates to an image communication apparatus which has a facsimile transmitter configured to transmit image data to a recipient based on a facsimile protocol. The image communication apparatus of claim 24 also has a memory which stores the image data to be transmitted by the facsimile transmitter. The image communication apparatus of claim 24 further has an e-mail transmitter which converts the stored image data into data for Internet transmission, attaches the converted data to an e-mail, and transmits the e-mail to a management center. The management center of claim 24 manages the e-mail transmitted by the e-mail transmitter and further is configured to connect to the image communication apparatus via the Internet. The e-mail transmitted by the e-mail transmitter

corresponds to the image data transmitted by the facsimile transmitter. The management center is independent of the recipient to which the image data is transmitted by the facsimile transmitter based on the facsimile protocol. Claim 33 generally recites a related method.

With respect to the Examiner's rejection of independent claims 20 and 30 under 35 U.S.C § 102 (e), OTSUKA et al. relate to a facsimile apparatus which executes a two-route transmission operation when it is determined that a transmission is urgent (Fig.15). In the two-route transmission, the facsimile apparatus transmits an e-mail with image data to a personal computer of the addressee via the Internet (Fig.15, S654) and transmits the image data to a facsimile apparatus of the addressee through the public communication switched network (Fig.15, S658). An e-mail address of the addressee is stored in the EEPROM 14 (Fig.7), corresponding to a facsimile number of the facsimile apparatus (col.18, lines 66-67 and col.19, lines 1-6). In other words, the e-mail and the facsimile data are transmitted to the same addressee (i.e., the e-mail and facsimile data are not transmitted independently).

However, as discussed above, OTSUKA et al. do not disclose an image communication apparatus which independently transmits the e-mail to each of the address of the recipient input by the panel and the e-mail address of the management center, the e-mail being transmitted to the management center based on the e-mail address stored in the memory, as generally recited in independent claims 20 and 30. Rather, OTSUKA et al. disclose the facsimile apparatus which transmits an e-mail with image data to the addressee stored in

the EPROM 14 and transmits the image data to the same addressee stored in the EEPROM 14.

OTSUKA et al. also do not disclose an image communication apparatus which independently transmits the e-mail to each of the address of the recipient input by the panel and the e-mail address of the management center, the e-mail address of the management center being independent of the recipient of the address input by the panel, as generally recited in the independent claims 20 and 30. Rather, as discussed above, in OTSUKA et al., the e-mail and the facsimile data are transmitted to the same addressee, since the e-mail address of the addressee is stored in the EEPROM 14 (Fig.7), corresponding to the facsimile number of the same addressee as the e-mail address (col.18, lines 66-67 and col.19, lines 1-6).

On the other hand, an embodiment of the present invention discloses an image communication apparatus which independently transmits the e-mail to each of the address of the recipient input by the panel and the e-mail address of the management center, the management center managing information that the image communication apparatus transmits to the address of the recipient input by the panel, and being further connected to the image communication apparatus via the Internet, the management center being distinct from the recipient of the address input by the panel, the e-mail address of the management center being independent of the recipient input by the panel, the e-mail being transmitted to the management center based on the e-mail address stored in the memory.



Thus, independent claims 20 and 30 are clearly patentable over OTSUKA et al. Therefore, it is respectfully submitted that the features recited in Applicant's independent claims 20 and 30 are not disclosed in OTSUKA et al., and it is requested that the Examiner withdraw the rejection of these claims, as well as the claims dependent therefrom.

With respect to the Examiner's rejection of independent claims 24 and 33 under 35 U.S.C § 102(e), OTSUKA et al. do not disclose an image communication apparatus which transmits image data to a recipient based on a facsimile protocol and transmits the e-mail to a management center, the management center managing the e-mail transmitted by the e-mail transmitter, the transmitted e-mail corresponding to the image data transmitted by the facsimile transmitter, the management center being distinct from the recipient to which the image data is transmitted by the facsimile transmitter based on the facsimile protocol. Rather, as discussed above, OTSUKA et al. disclose the facsimile apparatus which transmits an e-mail with image data to the addressee and transmits the image data to the same addressee as the e-mail. In other words, in OTSUKA et al., the e-mail and the facsimile data are transmitted to the same addressee, since the e-mail address of the addressee is stored in the EEPROM 14 (Fig.7), corresponding to the facsimile number of the same addressee as the e-mail (col.18, lines 66-67 and col.19, lines 1-6).

On the other hand, an embodiment of the present invention discloses an image communication apparatus which transmits image data to a recipient based on a facsimile protocol and transmits the e-mail to a management center, the

management center managing the e-mail transmitted by the e-mail transmitter, the transmitted e-mail corresponding to the image data transmitted by the facsimile transmitter, the management center being distinct from the recipient to which the image data is transmitted by the facsimile transmitter based on the facsimile protocol, as recited in independent claims 24 and 33.

Thus, independent claims 24 and 33 are clearly distinguished over OTSUKA et al.

Therefore, it is respectfully submitted that the features recited in Applicant's independent claims 24 and 33 are not disclosed in OTSUKA et al., and it is requested that the Examiner withdraw the rejection of these claims, as well as the claims dependent therefrom.

Absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claims 20, 24, 30, and 33 and the claims dependent therefrom, these claims are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102.

With respect to the Examiner's rejection of dependent claims 22, 26, 32, and 35 under 35 U.S.C. § 103 (a), since these claims 22, 26, 32, and 35 are dependent from an allowable independent claim, which is allowable for at least the reasons discussed *supra*, these claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further

define the present invention over the references of record. Applicant further notes that the amendments made to dependent claims 21, 22, 31 and 32 have been made to change "destination" to ---recipient--- (in accordance with the Examiner's Advisory Action of September 28, 2005), thereby rendering this terminology consistent with the claims from which they depend. Accordingly, the Examiner is respectfully requested to withdraw all rejections under 35 U.S.C. § 103 (a).

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding objection and rejections, and an indication of the allowability of all the claims pending in the present application in due course.

### **SUMMARY AND CONCLUSION**

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has canceled the some rejected claims without prejudice or disclaimer, and amended the some other rejected claims for consideration by the Examiner. With respect to the pending claims, Applicant has eliminated the basis for the rejection. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Applicant notes that this clarifying amendment is being made to advance prosecution of the application to allowance, and with respect to the added claimed features argued as deficient in the prior art, should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto. For example, as discussed *supra*, the amendments made to dependent claims 21,

P19157.A10

22, 31 and 32 have been made merely to render the terminology therein consistent with the claims from which they depend.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Kiyoshi TOYODA

William S. Boshnick  
Reg. No. 44,550



Bruce H. Bernstein  
Reg. No. 29,027

October 20, 2005  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191